

REMARKS

Claim 22 has been amended to correct an error raised by the Examiner, and claims 12-22 remain in the case.

The Examiner rejects claims 17 and 22 under 35 USC 103(a) as being unpatentable over Beard et al '800. In our response of 22 October 2003, the claims (including 17 and 22) were specifically amended or added to further distinguish said claims from Beard et al.

The Examiner has made the rejection final, and therefore examination on the merits of the case is considered closed and argument as to the allowability of finally rejected claims is generally not considered. However, there are issues in the present case with regard to the viability of the references cited by the Examiner which need to be addressed, and the Examiner's consideration of the entire remarks below before deciding on this case is respectfully requested.

The response dated 10/22/2003 in the present case set forth with specificity the differences between the amended/added claims of the present application and Beard. These arguments/comments will not be repeated here, but it is requested that the Examiner reconsider same in light of the content below.

In the present Office Action, the Examiner admits that Beard lacks the teachings of the specific steps and details associated with the communication and vending servicing system, but has asserted that the differences are "well known in the communications and vending arts".

The Examiner further asserts that differences between Beard and the present claimed invention comprise an "obvious design choice". Applicant respectfully but strongly disagrees for reasons stated above (and specifically in the argument set forth in the 10/22/03 response), and

applicant respectfully challenges this factual assertion.. Beard requires different and much more expensive equipment, and the methodology of operation and results are wholly different, as indicated in the earlier Response. The present system fills a unique and new market niche created by the present system which previously did not exist, has been installed at locations nationwide with success and is made possible and practical due to current technological advances that did not exist in the past. The prior art teaches no such system, and Beard has been cited as the only 103 reference comprising legitimate prior art.

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facts

**MPEP 2144.03 Requires Specificity of the reasoning and facts
when Relying upon "Common Knowledge"**

The Examiner's sole indicated rationale for finding the claims "obvious" over Beard is the non-explicit statement "it would have been an obvious design choice to one of ordinary skill in the art at the time of the invention to modify Beard et al to incorporate specific details and steps that are well known in the communications and vending arts into the system of Beard, in order to achieve a desired outcome or result." (Emphasis ours)

However, under *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002) and *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697, general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. It is respectfully submitted that no such "specific factual findings and concrete evidence" are present here.

As required under well accepted jurisprudence and MPEP 2144.03 (B), if a notice that the

differences are "well known" or "common knowledge" is made by the Examiner, the basis for such reasoning must be set forth explicitly:

"The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made."

In the present case, it would appear that the Examiner is relying upon personal knowledge to support his finding of what is known in the art. Accordingly, the undersigned respectfully requests that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanations to support the finding, as required under 37 CFR 1.104(d)(2):

*a Affidavit
by
Examiner*

"When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons." (emphasis ours)

**The Present Application Predates Butler,
therefore Butler is not a valid 103 Reference**

The Examiner has further rejected claims 12-16 and 18-21 under 103(a) as being unpatentable over Beard in view of Butler.

Regarding Butler (which is not a patent but a published patent application), the filing date is 02/21/2002, which is over 28 months after the filing date of the present 09/678,915 application. The Butler published application thereby does not in and of itself comprise an appropriate reference

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under 35 USC 103. The Butler published application does claim the benefit of a **provisional application**, but the contents of said application are unknown, and it is respectfully asserted that it is unreasonable to infer that its contents include whatever references the Examiner is not relying upon in rejecting the present application.

More importantly, under 35 USC 119 (e)(1), a utility application claiming the benefit of a provisional application must be filed within 12 months of the date of filing of the Utility application in order to receive the priority benefit of said earlier filed Provisional application.

The '975 provisional application is indicated in the Butler published application as having a filing date of August 30, 2000. Based upon its indicated filing date, the Butler published application '106A1 was filed more than one year after the filing date of said provisional, almost six months after the one year deadline, clearly far in excess of the statutorily required 12 month deadline to claim the benefit of the provisional application.

There has been no allegation that the provisional contained the subject matter of the '106 Butler published application, but even if it did, the Butler published application is not entitled to the priority date of the cited provisional application, as said published application was not filed within the 12 months from the provisional filing date.

As said provisional application is not considered a "printed publication" it cannot be cited on its own, and, in the present case, should be withdrawn as a reference.

Applicant's Invention Predates Butler

Even if Butler were a legitimate reference (which the applicant strongly disputes for reasons cited above), the invention of the present application predates Butler, as set forth in the attached

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Publication may
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1.131 declaration with attachments evidencing prior invention.

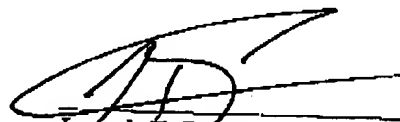
In the attached 1.31 declaration, the inventor sets forth with specificity facts relating to prior invention, with documentary evidence supporting said facts.

Accordingly, it is respectfully requested that Butler be withdrawn as a reference, which leaves again only the Beard '103 reference remaining. For reasons stated above and in the earlier response dated October 22, 2003 (the contents of which are incorporated herein by reference), not only is the invention of the present application novel, but also "not obvious" over Beard. The present claims set forth a specific methodology different from Beard utilizing equipment which is different from Beard. The present claims do not read upon Beard, and Beard does not teach, suggest, or otherwise anticipate the claimed methodology of the present claims.

Thus, on reconsideration, it is respectfully submitted that the present claims should be allowed as being patentable under 35 U.S.C. 103.

If additional issues remain, and the Examiner is of the opinion that same could be resolved by telephone amendment, the undersigned respectfully requests same at (985) 845-0000.

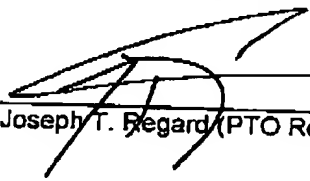
Respectfully submitted,



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CERTIFICATE OF FAXING

I HEREBY CERTIFY that the present document was faxed to the Commissioner for Patents, 703 872-9306, this 19th day of February, 2004.



Joseph T. Regard (PTO Reg 34,907)